BZ4

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,424	08/10/2000	Peter Beran	2883/0G357	6052

7590 07/14/2004

Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER	
SCHLAIFER, JONATHAN D	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/636,424	BERAN ET AL.	
	Examiner	Art Unit	
	Jonathan D. Schlaifer	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to Amendment to application 09/636,424 filed on 5/5/2004.

2. The drawings were received on 5/5/2004. These drawings are acceptable.

3. The objections to Claims 1 and 14 are withdrawn as necessitated by amendment.

4. Claims 1-20 are pending in the case. Claims 1 and 14-15 have been amended. Claims 1, 15, and 19-20 are independent claims. Claims 19-20 are new claims

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1, 3, 9-11 and 15-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. (USPN Re. 30,666—filing date 9/25/1975), hereinafter Mitchell, further in view of Ball et al. (USPN 6,240,391 B1—filing date 5/25/1999), hereinafter Ball**

6. **Regarding independent claim 1,** Mitchell discloses a method for synchronizing audio data to text data from a source (Mitchell's invention, as disclosed in the Abstract, is a printed text with synchronized audio inclusions). Mitchell further discloses segregating a source text data of a given format into a plurality of text sections (because the text is in the form of a book, it is divided into pages is as is clear from Fig. 1-3). Finally, since the audio recordings are individually cross-referenced to the text, (as described in the Abstract), presumably the recordings are produced by recording in any order audio data

portions each corresponding to a text section. Mitchell fails to disclose converting each recorded audio portion into an audio data file, assembling the audio data files in a sequence corresponding to the given format of the source text data, and generating for said assembled data files a playback control file indicating points of navigation of the source text data. However, Ball discloses in col. 25, lines 27-39 that recorded audio may be converted into an audio data file to facilitate transmission over a network, and since the audio files are attached to network messages, they must be assembled into a sequence in order to be transmitted successfully. It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the recorded audio into files and to assemble them into a sequence in order to facilitate their transmission over a network. Furthermroe, in col. 25, lines 1-26, Ball discloses generating for said assembled data file a playback control file indicating points of navigation of the source text data because it allows the user to manipulate the audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a playback control file because it would allow the user to manipulate the audio.

7. **Regarding dependent claim 3,** Mitchell clearly discloses that the text is divided into sections by pages, as show by Figures 1-3.

8. **Regarding dependent claim 9,** Mitchell discloses in the Abstract that the audio portions of the audio-visual information system are recorded in discrete portions as adjuncts to the text, hence implying that the audio portions are recorded by one or more narrators in any sequence and at any time or times.

9. **Regarding dependent claim 10,** it was notoriously well known in the art at the time of the invention that one could use at least two narrators in order to provide different narrative voices and that computers are used to provide an easy way of recording information. It would have been obvious to one of ordinary skill in the art at the time of the invention to use at least two narrators in order to provide different narrative voices and have computers provide an easy way of recording information.

10. **Regarding dependent claim 11,** it was notoriously well known in the art at the time of the invention that terminals whose operation must be coordinated are coordinated by being connected by at least one of a local area network, a wide area network, an intranet, and an Internet connection because these connections facilitate collaboration. It would have been obvious to one of ordinary skill in the art at the time of the invention to connect the terminals with a local area network, a wide area network, an intranet, and an Internet connection because these connections facilitate collaboration.

11. **Regarding independent claim 15,** it is an apparatus that performs the method of claim 1, and may be rejected under similar rationale.

12. **Regarding dependent claim 16,** it is an apparatus that performs the method of claim 2, and may be rejected under similar rationale.

13. **Claim 2 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball further in view of Barbara et al. (USPN 5,926,789—filing date 12/19/1996), hereinafter Barbara**

14. **Regarding dependent claim 2,** Mitchell and Ball fail to disclose that said playback control file contains links to corresponding point of navigation of said audio data files.

However, Barbara discloses in col. 1, lines 60-67 that audio items on pages are indexed via links in order to aid in their retrieval. It would have been obvious to one of ordinary skill in the art at the time of the invention to have navigational links to the audio files to aid in retrieving the audio data.

15. **Claim 4 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball further in view of Lowe et al. (USPN 5,695,401—filing date 12/2/1994), hereinafter Lowe**

16. **Regarding dependent claim 4,** Mitchell and Ball fail to disclose a method wherein a narrator reads a selected text section to form an audio portion and produces a mark of the beginning and end of the text section recorded as an audio portion to mark the points for converting to an audio data file. However, Lowe, in col. 8, lines 25-35, discloses the use of marking start and end points of narration in order to facilitate the procedure by which narration is added by clarifying when it should start and stop. It would have been obvious to one of ordinary skill in the art at the time of the invention to mark the beginning and end of narration in order to clarify when it should start and stop.

17. **Claims 5, 13-14, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball further in view of Reinold et al. (USPN 6,335,768 B1—filing date 5/4/1998), hereinafter Reinold**

18. **Regarding dependent claim 5,** Mitchell and Ball fail to disclose a method further comprising the steps of placing the assembled audio data files and playback control file on a medium for audio playback of said audio data files and display of said playback control file. However, Reinold, in col. 4, lines 45-60 and col. 5, lines 5-20 discloses the

encoding of the audio into formats such as RealAudio and WAV, for which there are standard players available, onto a storage medium, such as a CD-ROM or a DVD, in order to provide a hardware basis for interacting with the audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to transfer the audio data files and the player on a CD or DVD as in Reinold's invention in order to provide a hardware basis for interacting with the audio.

19. **Regarding dependent claim 13,** Mitchell and Ball fail to disclose a method further comprising storing the playback control data, the audio and the text data on a portable computer-readable medium. However, Reinold, in col. 4, lines 45-60 and col. 5, lines 5-20 discloses the encoding of the audio into formats such as RealAudio and WAV, for which there are standard players available, onto a portable storage medium, such as a CD-ROM or a DVD, in order to provide a hardware basis for interacting with the audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to transfer the audio data files and the player on a CD or DVD as in Reinold's invention in order to provide a hardware basis for interacting with the audio.

20. **Regarding dependent claim 14,** Mitchell and Ball fail to disclose a method wherein the portable computer readable medium comprises at least one of a CD-ROM, a DVD-ROM, a ZIP disk, and a floppy disk. However, Reinold, in col. 4, lines 45-60 and col. 5, lines 5-20 discloses the encoding of the audio into formats such as RealAudio and WAV, for which there are standard players available, onto a portable storage medium, such as a CD-ROM or a DVD, in order to provide a hardware basis for interacting with the audio. It would have been obvious to one of ordinary skill in the art at the time of the invention

to transfer the audio data files and the player on a CD or DVD as in Reinold's invention in order to provide a hardware basis for interacting with the audio.

21. **Regarding dependent claim 17,** it is an apparatus for playing back the medium encoded by the method of claim 5 and hence the rejection of this claim is the logical extension of that claim.

22. **Claim 6 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball, further in view of Reinold, further in view of Barbara**

23. **Regarding dependent claim 6,** Mitchell and Ball and Reinold fail to disclose that said playback control file contains links to corresponding point of navigation of said audio data files. However, Barbara discloses in col. 1, lines 60-67 that audio items on pages are indexed via links in order to aid in their retrieval. It would have been obvious to one of ordinary skill in the art at the time of the invention to have navigational links to the audio files to aid in retrieving the audio data.

24. **Claims 7-8 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball, further in view of Reinold, further in view of Holm (USPN 5,850,629, see IDS—filing date 9/9/1996)**

25. **Regarding dependent claim 7,** Mitchell, Ball, and Reinold fail to disclose a user selecting a text section to be played back by selecting the section from the display, and audio reproduction of the selected text section. However, Holm, in the Abstract, discloses text-to-speech production from selected sections of documents in a display in order to provide auditory versions of visual material. It would have been obvious to one

of ordinary skill in the art at the time of the invention to incorporate Holm's text-to-speech from selection features into Mitchell, Ball, and Reinhold's inventions in order to provide auditory versions of visual material.

26. **Regarding dependent claim 8,** Mitchell, Ball, and Reinold fail to disclose that the source data text is played on the medium and the text is displayed upon selection from the playback control file. However, it is inherent to Holm that the source data text be placed upon the medium because there must be a physical source of the text, which is clearly shown as being displayed in Figure 1 to provide the user with an interactive model of the text that is spoken. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the text on the medium and display the text because there must be a physical basis of storage for the text for it to be displayed as in Holm, which is done to provide the user with an interactive model of the text that is spoken.

27. **Regarding dependent claim 18,** it is an apparatus for playing back the medium encoded by the method of claim 8 and hence the rejection of this claim is the logical extension of that claim.

28. **Claims 12 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball, further in view of Puranik et al. (USPN 6,003,090—filing date 4/23/1997), hereinafter Puranik**

29. **Regarding dependent claim 12,** Mitchell and Ball fail to disclose that the text data is stored in at least one of an HTML format and a XML format. However, Puranik cites several advantages of using HTML in col. 8, lines 15-25, including hypertext links, HTTP, and event information. It would have been obvious to one of ordinary skill in the

art at the time of the invention to use HTML in order to take advantage of hypertext links, HTTP, and event information.

30. **Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell, further in view of Ball.**

31. **Regarding independent claim 19,** it is essentially the same as claim 1 except for the limitations that the final generation step of the playback control file occurs after each audio data file has been assembled in the sequence corresponding to the given format of the source text data. However, this would have been an obvious limitation because it was notoriously well known in the art at the time of the invention that if one wishes to indicate points of navigation corresponding with a format, the data file to which the navigation points are to be added must be organized in a manner corresponding with the format. It would have been obvious to one of ordinary skill in the art at the time of the invention to assemble audio data files in a manner similar to this format because it would allow navigation points to be successfully added because it would be working in conjunction with the underlying structure of the file. The remainder of the claim may be rejected under similar rationale to claim 1.

32. **Regarding independent claim 20,** it is an apparatus that performs the functionality of claim 19, and is rejected under similar rationale.

Response to Amendment

33. Applicant's arguments filed 5/5/2004 have been fully considered but they are not persuasive.

34. Applicant alleges that Examiner's case for *prima facie* obviousness under 35 U.S.C. 103(a) for claims 1, 3, 9-11 and 15-16 is not sufficient. The Examiner asserts specifically that Ball may be combined successfully with Mitchell despite the Applicant's allegations because Ball contains the limitation of assembling audio files into a sequence and it is analogous art, with the motivation of facilitating the transmission of the audio files over a network.

35. Applicant alleges that there is no evidence within Mitchell for "recording in any order". The Examiner responds by drawing the Applicant's attention to col. 4, lines 20-30, which describes how the contents of Mitchell's invention may be produced using multiple recording sessions. Clearly, if the contents of the invention can be produced in multiple recording sessions, it would have been obvious to produce them in any order because this would have offered the benefit of allowing the producer of Mitchell's invention to produce subparts of the invention in any convenient order.

36. Applicant alleges that there is no support for the assertion on the Examiner's part that Ball's audio files "must be assembled into a sequence in order to be transmitted successfully". However, in col. 3, lines 35-40, such a reference to a sequence may be found.

37. Applicant alleges that the step of "recording in any order audio data portions each corresponding to a text section is missing from Mitchell and Ball. However, the Examiner reasserts since the audio recordings are individually cross-referenced to the text, (as described in the Abstract of Mitchell), presumably the recordings are produced by recording in any order audio data portions each corresponding to a text section.

38. Applicant alleges that the Mitchell and Ball do not disclose generating the playback control file subsequent to recording the audio portions. However, as noted in the Action, in col. 25, lines 1-26, Ball discloses generating for said assembled data file a playback control file indicating points of navigation of the source text data.

39. Applicant alleges that the combination of Mitchell and Ball results in an inoperable device. The Examiner respectfully submits that by selective incorporation of features of Ball into Mitchell, there is no gross incompatibility between the devices. The issue of the user embedded instructions corrupting data is irrelevant because it would have been obvious to lock factual information so it would be read-only.

40. Applicant alleges that claim 2 is patentable over Barbara because Barbara fails to disclose the recording of audio. However, Applicant fails to note that Claim 2 descends from Claim 1, where the recording of audio is inherent to Mitchell.

41. Applicant alleges that the rejection of claim 4 is insufficient because Lowe does not disclose the features of claim 1. However, because this is a rejection under 35 U.S.C. 103(a), Lowe need only comprise features which can be combined with the other pieces of art in the rejection, which do disclose the features of claim 1. Hence the applicant's traversal of the claim is invalid.

42. Applicant alleges that Lowe's cue points are not the same as the cue points of the invention because they are not selected by the narrator. However, the claim only states that the narrator produces the cue points, not that they are set by the narrator. This can be interpreted as producing the preset cue points for manipulation, which is disclosed by Lowe.

43. Applicant alleges that Reinold and Holms and Puranik lacks recording audio. Assuming this to be the case, recording audio would still descend via inherency from the parent claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 4,985,697 (filing date 1/21/1988)—Boulton

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS

STEPHEN S. HONG
PRIMARY EXAMINER